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APPLICATION NO.	FILING DATE	. FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,823	08/06/2003	Eiji Hamamoto	030892	6752
38834	7590 11/12/2004		EXAM	INER
	AN, HATTORI, DANI	JUBA JR, JOHN		
1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			ART UNIT	PAPER NUMBER
			2872	. •
			DATE MAILED: 11/12/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
	10/634,823	HAMAMOTO, EIJI			
Office Action Summary	Examiner	Art Unit			
	John Juba, Jr.	2872			
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address			
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	of (a). In no event, however, may a reply be time within the statutory minimum of thirty (30) days will apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	ely filed swill be considered timely. the mailing date of this communication. O (35 U.S.C. § 133).			
Status					
1) Responsive to communication(s) filed on	_•				
2a) ☐ This action is FINAL . 2b) ☐ This	This action is FINAL. 2b) ☐ This action is non-final.				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 45	3 O.G. 213.			
Disposition of Claims		•			
4) ⊠ Claim(s) 1-15 is/are pending in the application. 4a) Of the above claim(s) is/are withdraw 5) □ Claim(s) is/are allowed. 6) □ Claim(s) is/are rejected. 7) □ Claim(s) is/are objected to. 8) ⊠ Claim(s) 1-15 are subject to restriction and/or expressions.	vn from consideration.				
Application Papers					
 9) ☐ The specification is objected to by the Examine 10) ☑ The drawing(s) filed on <u>06 August 2003</u> is/are: Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) ☐ The oath or declaration is objected to by the Examine 	a)⊠ accepted or b)⊡ objected t drawing(s) be held in abeyance. See ion is required if the drawing(s) is obj	e37 CFR 1.85(a). ected to. See 37 CFR 1.121(d).			
Priority under 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the priority application from the International Bureau * See the attached detailed Office action for a list	s have been received. s have been received in Application ity documents have been receive I (PCT Rule 17.2(a)).	on No ed in this National Stage			
Attachment(s)	•				
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:				

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Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 5, drawn to a method of manufacturing a polarizing including stretching and dying a film, classified in class 264, subclass 1.34.
- II. Claims 6 11, drawn to a stretched, dyed polarizer, classified in class 359, subclass 490.
- III. Claims 12 15, drawn to a film stretching apparatus, classified in class425, subclass 71.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a process of dry-stretching a web, taking-up the web, and then dyeing and borating; dyeing and borating a web, taking-up the web, and subsequently dry-stretching the web; or wet-stretching the web in a single stretching operation. The recitation of the manner in which the product was made does not convey any clear *structural* distinction between the claimed product and a product formed by another process. Even if the wet processed film can be shown to be *structurally* different from a dry-processed film, there appear to be no *structural* differences between a wet-stretched polarizer stretched in a single step and a wet-stretched polarizer stretched in at least two stretching steps. Any

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differences appear to lie in the tendency toward breakage at the time of stretching rather than to structural differences in the final polarizer, itself.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used for orienting any polymer film to impart improved strength and stability in a process that simultaneously coats the film with a slip agent, anti-static agent, anti-stain agent, anti-reflection agent, or adhesive, the stretching process being undertaken a single time.

Inventions II and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case Applicant would argue that the apparatus as claimed is novel and non-obvious. The apparatus can be used for making a different product, such as an oriented polymer film coated with an adhesive or anti-stick/anti-stain material (such as PTFE). Further, the product as claimed can be made by a materially different apparatus, such as a tenter. The recitation of the manner in which the product was made does not convey any clear *structural* distinction between the claimed product and a product formed by another process in another apparatus.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the search required for Group III is not required for Group II, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Nicolas Seckel on November 10, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Juba whose telephone number is (571) 272-2314. The examiner can normally be reached on Mon.-Fri. 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Drew Dunn whose number is (571) 272-2312 and who can be reached on Mon.- Thu., 9 – 5.

The centralized fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

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